

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action dated March 17, 2008. Claims 2, 9, and 12 were previously cancelled. Claims 1, 8, 10, and 11 are amended as set forth above. Thus, Claims 1, 3-8, 10-11, and 13-17 remain pending and stand rejected in the application. Applicant submits that no new matter has been added with the amendments. Applicant respectfully requests reconsideration of the application in accordance with the following remarks.

Section 112 Rejections

Claims 1, 10 and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement with regards to the claim element of “[c]onverting the text content in an unambiguous reading order into canonical form.” Applicant respectfully traverses the rejection and holdings therein because the originally filed application clearly describes the submit matter such that one skilled in the art would understand that the inventor had possession of the claimed invention at the time the application was filed. *See* M.P.E.P. § 2163 (citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). There is a strong presumption that the claimed invention is adequately described when the application is filed, or in other words, it is presumed that originally filed claims comply with the written description requirement. *See* M.P.E.P. § 2163(I)(A).

Specifically, the originally filed application recites that “the text [of the electronic document] must have an unambiguous reading order for generating the control code . . . The unambiguous reading order used for generating and validating the control code 415 can be any reading order that is used by both the workflow system 100 and the external entity 105.” *Present Application*, 7:16-22. Applicant believes the rejection under § 112, first paragraph, is a result of a misunderstanding of the claim element. The claim portion reciting “in an unambiguous reading order” defines the text content. Thus, the text content, which is “in an unambiguous reading order,” is converted into canonical form. With that reading of the claim, it is indisputable that Applicant had possession of the claimed invention at the time the application

was filed. For at least these reasons, Applicant respectfully requests that the rejections of Claims 1, 10, and 11 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claims 1, 10 and 11 stand further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action states that “[t]he specification does not specify what is meant by an unambiguous reading order.” Office Action, p. 5. Applicant respectfully traverses this rejection and all the assertions and holdings therein.

Applicant notes that the M.P.E.P. does not support the present rejection. The M.P.E.P. §2173.02 clearly states that:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. ... See, e.g., *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) (“The requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles... Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.”).

Applicant respectfully asserts that the Examiner has not shown that the present claims are “insolubly ambiguous without a discernible meaning after all reasonable attempts at construction” as required. See *Metabolite Labs.* at 1366; M.P.E.P. §2173.02.

Applicant respectfully notes that the claim element identified as indefinite, particularly when read in the light of the specification, is instead both clear and definite as written. Specifically, Claim 1 recites “converting the text content in an unambiguous reading order into

canonical form.” In other words, text content that is in an unambiguous reading order is converted into canonical form. As clearly defined in the specification, “[t]he unambiguous reading order . . . can be any reading order that is used by both the workflow system 100 and the external entity 105.” Present Application, 7:20-22. Thus, the specification does specify what is meant by an unambiguous reading order. For at least these reasons, Applicant respectfully requests that the rejections of Claims 1, 10, and 11 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Section 103 Rejection

Claims 1, 3-8, 10-11, and 13-17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater (“*Slater*”), in view of U.S. Patent No. 6,634,559 to Shioda (“*Shioda*”). Applicant respectfully traverses these rejections and holdings therein because *Slater* and *Shioda*, whether individually or in combination, fail to teach, suggest, or disclose various aspects of the present claims.

Put simply, *Slater* fails to teach printing an electronic document for use with an external entity that does not exchange electronic documents with a workflow system, while *Shioda*, although describing a printed data sheet associated with an electronic document, merely teaches including a reduced image, or preview, of the document on the data sheet. These references do not teach, however, that the printed document includes a full-size version of the electronic document’s text content, allowing for full and easy review of the electronic document by a person associated with the external entity.

For example, the *Slater-Shioda* combination at least fails to teach, suggest, or disclose creating a print out of an electronic document that includes “a full-sized version of the document appearance,” where the document appearance is a human-readable appearance representing the text content of the electronic document, as recited in Claim 1. (emphasis added). As stated, *Slater* simply does not teach printing the electronic document. *Shioda*, on the other hand, teaches that a printed data sheet can be used to manually distribute electronic documents between users within an office environment. *See Shioda*, 2:40-47. The printed sheet comprises an upper portion and a lower portion. The lower portion of the data sheet represents an encoded version of the electronic document presented in encoded, or non-human-readable, form. *See, e.g.*,

Shioda, FIG. 1-3; 5:35-46, 6:18-23. The encoded version of the electronic document is only made human-readable after processing the printed data sheet with a “data reading unit” (e.g., a scanner), and then using a “decoding unit” on the encoded portion of the processed data sheet to obtain the entirety of the decoded electronic document. *See id.* at 3:25-28. The upper portion of the data sheet includes, among other items, a “reduced image” of the document allowing “a user to preview the document.” *Id.* at 3:24-25. By reviewing the reduced image or preview, *Shioda* teaches that the “user can recognize contents of a document recorded on the data sheet.” *Id.* at 6:38-40. The reduced image of the electronic document is not a full-size version of the text content of the electronic document as required by Claim 1. Simply being able to recognize an electronic document’s contents using a preview of the document’s contents does not provide the same benefit as the disclosed print out of Claim 1 – namely the ability of a user to review a full-sized, human-readable version of the electronic document contained on the face of the print out.

Accordingly, the *Slater-Shioda* combination fails to teach, suggest, or disclose each and every element recited in example Claim 1. For at least these reasons, Applicant respectfully requests withdrawal of the § 103 rejections, as well as reconsideration and allowance of Claim 1 and its dependents. Further, independent Claims 8, 10, and 11 recite certain elements similar to those of Claim 1. For at least reasons analogous to those discussed with regard to Claim 1, independent Claims 8, 10, and 11, as well as their dependents, are allowable over the *Slater-Shioda* combination.

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CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fees are believed to be due at this time. If any extension of time is required, Applicant hereby requests the appropriate extension of time. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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